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APPLICATION NO. 05/753,272	FILING DATE 04/19/97	FIRST NAMED INVENTOR FINSERWALD	ATTORNEY DOCKET NO. 00550
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MM51/0323

EXAMINER ST CYR, D
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ART UNIT 2076	PAPER NUMBER #12
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DATE MAILED: 03/23/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/783,372

Applicant(s)

Martin Finsterwald

Examiner

Daniel St.Cyr

Group Art Unit

2876

☒ Responsive to communication(s) filed on Jan 11, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 39-42 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 39-42 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2876

### DETAILED ACTION

1. Receipt is acknowledged of the amendment filed January 11, 1999 in which claims 1-37 have been canceled and claim 39 has been amended.

#### *Specification*

2. Applicant has failed to include the appropriate headings, such as "Background of the Invention," "Brief Description of the Drawings," etc. Correction should be made in the next response.

#### *Claim Objections*

3. Claim 41 is objected to because of the following informalities: in line 3 " it " should be -- the evidence --. Appropriate correction is required.

#### *Claim Rejections - 35 U.S.C. § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al, US Patent No. 5,056,019 (of the record) in view of Small, US Patent No. 5,791,991.

Schultz et al discloses an automatic purchase reward accounting system and method comprising the steps of: applying a unique code (UPC codes ) to evidence of the product (col. 7, line 53); giving the customer a certificate 18 (evidence) including rewards earned after the

Art Unit: 2876

customer has completed the purchase (see col. 8, line 56 +); establishing a central station 3 and retention station 20; identifying the customer using the identifying code 21a. (See figure 2).

Re claim 40, the certificate 18 serves as a receipt wherein the receipt is sent to the customer (see col. 8, lines 64+).

Re claim 41, the code applied to the product is related to the product in order to identify the rewards earned by the customer, the evidence (certificate) is not sent to the customer until the purchase is completed which indicates that the evidence remains invisible to the customer. (see col. 8, lines 48-65).

Schultz et al fail to disclose or fairly suggest that the method of accessing the customer account is via the Internet wherein the processing station digitally processes the account and the customer receives the code digitally.

Small discloses an interactive consumer product method and match game wherein the customer accesses his/her account via the Internet, the customer digitally receives a rebate coupon which includes products codes and the customer ID code after completing a transaction. The customer can transmit the coupon electronically through the Internet to the data processing station. ( see figures 2 and 8).

It would have been obvious for a person of ordinary skill in the art, at the time the invention was made, to implement the Internet technology of Small to the teaching of Schultz et al in order to provide Schultz et al with a more effective products promotion system with minimal expense. Furthermore, such implementation would be more convenient wherein the customers can

Art Unit: 2876

access the system in the comfort of their home at any time of the day which would produce more advertizement. Therefore, such implementation would have been an obvious expedient within the ordinary skill in the art.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kanter, US Patent No. 5,537,314, discloses a referral recognition system for an incentive award program. Goldhaber et al, US Patent No. 5,794,210, disclose an atteantion brokerage. Sirbu et al, US Patent No. 5,809,144, disclose a method and apparatus for purchasing and delivering digital goods over network.

Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via PTO fax machine located at Crystal plaza 4. The fax number is **(703)308-7722**.

Any inquiry concerning this communication from the examiner should be directed to **Daniel St.Cyr** whose telephone number is **(703) 305-2656**. The examiner can normally be reached between the hours of **8:00AM to 4:30PM** Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Donald T. Hajec**, can be reached at **(703) 308-4075**.

Any inquiry of general nature relating to the status of this application should be directed to the group receptionist whose telephone is **(703)308-0956**.

Application/Control Number: 08783372

Page 5

Art Unit: 2876

March 12, 1999

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